

REMARKS

The Office has required restriction between group I (claims 1-17) and group II (claims 18-37). Applicant hereby elects group II with traverse.

Applicant traverses the restriction inasmuch as the Office has failed to establish distinction of the alleged inventions under MPEP 806.05(c), and even if distinction has been established, restriction is improper after three previous examinations of the restricted independent claims 1, 10 and 18 under MPEP 808.02 and 803 (8th ed., rev. 2).

Initially, the Office relies upon MPEP 806.05(c) in support of the restriction of inventions and which states that the inventions are distinct if the combination *does not* require the particulars of the subcombination for patentability (to show novelty and unobviousness) and the subcombination can be shown to have utility either by itself or in other and different relations.

There is no evidence of record that the claims 1-17 requires the particulars of the subject matter of claims 18-37 for patentability. Indeed, claims 1-17 have been allowed since the original filing and independent claim 18 has been examined and rejected three times. Accordingly, it is nonsensical to state claims 1-17 of group I are patentable for the particulars of group II when the claims of group I have been allowed and the claims of group II have been examined and rejected and have not been indicated to recite allowable subject matter. *It may be assumed that claims 1-17 are allowed for reasons other than the particulars of claims 18-37 since claims 18-37 have been rejected no less than three times and currently remain rejected.* By definition, the first requirement for restriction under 806.05(c) for distinct inventions is not met and the restriction is improper for at least this reason.

Further, under the second requirement of MPEP 806.05(c) for proper restriction, apart from bald, conclusory allegations of the Office, there is no evidence that the subcombination has separate utility apart from the combination. For at least the above-mentioned compelling reasons, Applicant respectfully asserts that the Office has failed to establish under MPEP 806.05(c)

that restriction is proper and Applicant respectfully submits that restriction is not proper especially in consideration of MPEP 808.02 discussed below.

Applicant refers the Examiner to MPEP 808.02 (8th ed., rev. 2) entitled Related Inventions. It is stated in such MPEP section that where related inventions as claimed are shown to be distinct under MPEP §806.05(c)-(i) (subsection c is the alleged rationale for issuing the restriction requirement in the subject application), *the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following: (a) separate classification, (b) separate status in the art when they are classifiable together, or (c) a different field of search. It is further stated in MPEP 808.02 that where the classification is the same and field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist dividing among related inventions.* The Office has failed to provide any explanation to support restriction in the present application contrary to MPEP 808.02.

In view of the following prosecution history of the present application up to this point, it is clear that restriction is not proper. More specifically, Applicant notes the prosecution of the subject application has proceeded as follows:

First Office Action mailed December 9, 2003 allowing claims 1-17 and rejecting claims 18-20.

First Office Action Response mailed March 9, 2004, adding new claims 21-29 which depend directly or indirectly from independent claim 18.

Second Office Action mailed May 26, 2004 allowing claims 1-17 and rejecting claims 18-29.

Second Office Action Response mailed August 25, 2004 which added new claims 30-36. The undersigned and the Examiner

discussed the Second Office Action during a telephonic interview.

Third Office Action mailed January 13, 2005 allowing claims 1-17 and rejecting claims 18-36.

Third Office Action Response mailed April 13, 2005 which added new claim 37. The undersigned and the Examiner discussed the Third Office Action during a telephonic interview.

Accordingly, as set forth above, *the Office has searched and examined claims of both groups three previous times.* The only rejected independent claim (i.e., claim 18) has been examined three times in its original form.

The restriction requirement issued June 21, 2005 is entirely void of identifying any indication of separate future classification or field of search. Section B of MPEP 808.02 states that separate status in the art may be shown by citing patents which are evidence of such separate status, and also separate field of search. *No patents have been cited or other evidence offered to indicate the alleged separate status. In addition no separate field of search is required inasmuch as the pending independent claims have been examined on the merits three times.* There is no indication that a different classification is provided or a different field of search is required. No clear indication of separate future classification and field of search is provided. *As mandated by MPEP 808.02, no reasons exists for dividing among related inventions.*

Applicant further contends that any restriction is improper for at least the following reasons.

First, the Examiner has apparently already searched and examined the pending claims which are now the subject of restriction. Accordingly, now requiring elimination of any set of claims will not reduce the scope of searching, and thus there are no efficiencies gained by imposing a restriction requirement. In addition, restriction at this late time is not timely, and does not have any sense of fairness to Applicant.

Restriction is not proper since there is increased burden on the U.S. Patent and Trademark Office, on the Applicant and ultimately on the public in prosecuting multiple separate patent applications. For Applicant, splitting the invention into multiple cases increases costs associated with government fees, prosecution fees, and maintenance fees for multiple patents. For the PTO, there are increased costs associated with conducting multiple searches in multiple applications and multiple examinations for an invention that already has been searched and examined. It further ultimately produces a burden on the pertinent public that will review Applicant's commonly patented technology. Such people will be compelled to unnecessarily review multiple issued patents and file histories.

Pursuant to MPEP 803 (8th ed., rev. 2), it is stated that *if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.* In view of the prior three examinations of the present application, Applicant respectfully submits no serious burden exists and Applicant respectfully requests withdrawal of the restriction requirement for this additional reason.

As set forth above, the Office has failed to establish that the inventions are distinct under MPEP 806.05(c) and restriction is improper for at least this reason. Further, even if the inventions are distinct, restriction is not proper under MPEP 808.02 and 803 in view of the extensive previous prosecution of the present application including *examination of the claims three previous times on the merits* and two interviews of the undersigned and the Examiner.

Applicant respectfully asserts that the Examiner's restriction requirement is improper, and requests that the Examiner withdraw the restriction requirement and consider the already examined claims in this application at this time.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal

business hours (Pacific Time Zone).

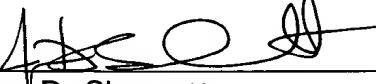
Respectfully submitted,

Laurence M. Hubby, Jr.

Dated:

7/21/05

By


James D. Shaurette

Reg. No. 39,833

Wells St. John P.S.

Telephone: (509) 624-4276

Facsimile: (509) 838-3424